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6P 3714

Docket 0065292

In the United States Patent and Trademark Office

In re Application of: Freeman, Victoria J.

Serial No.: 09/640,369 Group Art Unit: 3714
Filed: 08/17/2000 Examiner: Ashburn, Steven L.

Technology Center

For: METHOD AND APPARATUS FOR CONDUCTING A
COMPETITION USING A DIVIDED LITERARY WORK

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DATE OF DEPOSIT: 7/30/04 By: Auzville Jackson, Jr.
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APPEAL BRIEF

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

July 30, 2004

Sir:

I. REAL PARTY IN INTEREST

The real party in interest in the present application is Victoria J. Freeman, the inventor, of Norfolk, Virginia.

II. RELATED APPEALS AND INTERFERENCES

There are no other patent applications known to appellant or the appellant's legal representative that will directly affect or be affected by or have a bearing on the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

The claims presently pending in the application are claims 26-28, all of which have been finally rejected and are part of this appeal. The 3 claims on appeal are set forth in the Appendix at the end of this brief.

IV. STATUS OF AMENDMENTS

There has been no amendment filed subsequent to the Examiner's final rejection.

V. SUMMARY OF THE INVENTION

The present invention provides a method for promoting literacy and reading among children. (Specification page 2, lines 15 and 16).

The method promotes literacy and reading by conducting a competition related to a literary work in association with an advertisement.

Applicant has acted as her own lexicographer in the specification and uses the following terms set forth in the specification with special meanings as follows:

1. Literary work – “At a minimum, a literary work must comprise at least 100 words or more and constitute an original work of authorship.” See page 3, lines 23 and 24.
2. Associated with an advertisement – “Associated with an advertisement (e.g., a corporate name, a product name, a slogan, logo, icon, web site address, sound, description or illustration of product or service, or other

promotional device). Some or all of the playing pieces may not include advertisements, but could instead be distributed in conjunction with an advertising campaign. As one example, a competition sponsor may distribute pieces from its stores or by mail with the advertising implicit in the distribution from the sponsor.” See page 4, lines 2 to 8.

3. Playing pieces – “Playing pieces can comprise physical objects (e.g. cards, plastic tablets, and the like) or an intangible object (e.g., a computer-generated display on a web page. Combinations of the two are also possible; such that some playing pieces are distributed in the form of physical objects while other playing pieces are distributed over the Internet (e.g., displayed on the web sites of sponsors.” See page 5, lines 14 to 18.
4. Prize – “A prize such as books, cash, scholarships, computers, trips, awards, recognition, or the like.” See page 6, lines 11 and 12.
5. Distinct parts – “distinct parts, each of which has no readily apparent relation to the other parts.” See page 2, line 17. “Distinct part of the same literary work that contain a number of words, but which cannot be readily correlated with other playing pieces without reading the distinct part of the literary work in each playing piece.” See page 5, lines 1 to 3.

The invention involves the following:

Dividing a literary work (Specification Page 3, lines 24 and 25) into a correctly ordered sequence of words into a plurality of distinct parts with each part having no readily identifiable means for determining the correct sequence of words in the literary work (Specification Page 2, lines 16 and 17; Page 5, lines 1 to 3; Figure 5; element 501)

Next, a plurality of playing pieces are created (Page 5, lines 14 to 18; Figure 5, element 503) with each of the playing pieces comprising a distinct part. (Page 2, line 17; Page 5, lines 1 to 3; Figure 5).

Next, an advertisement is created. (Page 4, lines 2 to 8 and lines 10 to 15).

The advertisement is associated with and distributed with the plurality of playing pieces having a distinct part to members of the public. (Page 4, lines 2 to 8; Page 5, lines 11 to 12, Figure 5, element 504).

This is followed by collecting the playing pieces having a distinct part. (Page 5, lines 1 to 3; Page 6, lines 6 to 8; Figure 5, element 505).

The collected playing pieces are then sequenced into a correctly ordered sequence of words in the literary work. (Page 6, lines 6 to 8; Figure 5, element 505).

Next, the correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words are sent. (Page 6, lines 6 to 8). This is followed by the winning of a prize for the correctly ordered set of playing pieces. (Page 6, lines 10 to 12).

VI. ISSUES

The issues presented by this appeal are as follows:

- (A) Is the Examiner correct in not using the limitations as set forth in the specification when the inventor has acted as her own lexicographer?
- (B) Is the Examiner correct in not considering the preamble of the claim as a limitation?
- (C) Is the Examiner correct in the Final Rejection of claims 26 to 28 under 35 U.S.C. 103(a) as being unpatentable over Hopkins, et al., U.S. Patent 4,756,533 in view of Pritchard, U.S. Patent 1,217,632?

VII. GROUPING OF CLAIMS

The claims may be grouped together with Claim 26 being the significant claim.

VIII. ARGUMENT

(A) The Examiner has refused to interpret the claims by using Applicant's chosen words in the claims and cites *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Van Geuns stands for the proposition that claims are normally given their broadest reasonable interpretation and that limitations are not to be read into the claims. Applicant does not argue with this but it ignores the exception where the applicant defines his terms in the specification, that is, acts as her own lexicographer.

The inventor's definition and explanation of the meaning of a word or term as evidenced by the specification, controls the interpretation of that claim term as opposed, for example, to dictionary definitions (*Serrano v. Telular Corp.*, 111 F.3d 1578, 42 USPQ2d 1538 (Fed. Cir. 1997)).

It is well settled law that the inventor may be her own lexicographer. See Patent and the Federal Circuit, Sixth Edition, 2003 by Robert L. Harmon on pages 280 to 286 and cases cited therein.

In the present case, the applicant's need to act as her own lexicographer is important and essential in setting forth and understanding the claims.

(B) The Examiner in his Final Rejection stated: "the body of the claim is directed toward the claim and does not depend on the preamble for completeness. Hence the preamble's recitation of 'promoting literacy' has not been given patentable weight."

The Examiner is incorrect. The heart and soul of the invention is a method for promoting literacy and must be considered as a vital and restricting limitation on the claims.

A claim preamble is limiting "if it is necessary to give life, meaning, and vitality to the claim." See *Kropa v. Robie and Mahlman* 187 F.2d 150, 152 (CCPA 1951). *Kropa v. Robie and Mahlman* was cited by the Examiner and is a conspectus of prior cases in which the preamble was (1) held not to express limitation in claim and (2) where the

preamble either expressly or by necessary implication was considered to be a limitation upon the subject matter defined by the claim.

The holding in the case was that the words “An abrasive article” are essential to point out the invention defined by the counts. In our judgment, those introductory words give life and meaning to the counts, for it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article.”

This is the same situation we have here as the term “promoting literacy” in the preamble is required to give life and meaning to the claim, for it is only by that phrase that it can be known that the subject matter defined by the claim is to a method for promoting literacy.

It is believed clear from the above that the law and facts show that “promoting literacy” used in the preamble of the claim is a limitation in the claim and must be considered in an analysis of the claim.

(C) Claims 26 through 28 have been rejected as being unpatentable over Hopkins, et al. U.S. Patent 4,756,533 (Hopkins) in view of Pritchard U.S. Patent 1,217,632 (Pritchard). Comments on these two patents and improperly combining them relative to the present invention are set forth below:

Hopkins:

Hopkins discloses a multiple jig-saw puzzle promotional lottery game, which combines both skill and chance. The puzzle has identical jig-

saw patterns and may be played by the contestants simultaneously. Puzzle pieces for all of the puzzles are received from a common, unsegregated pool. The contestant is challenged to separate the puzzle pieces using only visual clues on their faces, to place the puzzle pieces in the correct places, and to collect all the pieces needed to solve one or more puzzles. The game may be combined with other promotional games, such as instant win games and sweepstake games. Hopkins encourages on-going contestant participation, making it useful for promotional activities.

Each contestant receives a game board that contains two or more puzzle boards. Each puzzle board contains a picture of a prize to be won in an outline of positions of puzzle pieces, which complete the puzzle. From time to time the contestant will receive game cards, which contain one more puzzle pieces to be placed on one of the puzzle boards to solve a portion of the puzzle by being placed within an outline of a corresponding position. The puzzle pieces, which contain a picture of a prize to be won, are not segregated in any manner, which would clue the contestant as to which puzzle board the piece should be placed on.

Contestants are challenged not only to complete correctly a jig-saw puzzle, but also must first determine on which puzzle board the piece should be placed. The puzzle boards have identically shaped jig-saw patterns, and so each puzzle piece is shaped to fit into an identical position in the jig-saw pattern of each puzzle board and the patterns may be shifted

90 degrees from the orientation of the previous puzzle. Thus the contestant's task is to use only the visual indication on the face of each puzzle piece to determine the correct position.

The awards or prizes are controlled by having only limited production of one particular puzzle piece corresponding to each puzzle board. If more than one prize is contemplated, then additional puzzle pieces can be created. All other puzzle pieces can be printed and distributed in large quantities enticing all of the contestants to continue playing until their puzzle boards are nearly complete.

Thus the Hopkins reference primarily relates to a puzzle lottery game using multiple jig-saw puzzles and there are no words utilized in the puzzle but only pictures.

Pritchard:

Pritchard discloses a picture puzzle, which utilizes a number of stamps arranged in a sheet form and from which the individual stamps can be separated. These stamps are chosen to form a picture, usually by combining nine of the stamps and gluing them to an appropriate page. The page may have a title at the top of the page, such as "Jack and Jill".

The various stamps are primarily illustrations except, in some instances, a few words may be used. Representative of the solved puzzle is Figure 5, where there are nine stamps located on a sheet for Little Jack

Horner, which it is mostly drawn to an illustration with each stamp an illustration by itself or a partial illustration. In this particular example, words are used on three of the stamps. Even after all the stamps are used, the resulting illustration has a text only 28 words in length.

It is also stated that the picture puzzle is not only entertaining and instructional for children, but is also applicable for an advertising medium as the pictures to be assembled can display the names of advertisers, their articles of manufacture, etc.

Thus, Pritchard shows a picture puzzle made up of pictures although a few of the stamps used in making up the pictures may include a few short verses.

Definitions and Claim Chart:

In order to better show how the presently claimed invention is not obvious over the combined references, each reference has been explained above and both are set forth in a claim chart below which shows why the two references, in combination, do not teach the claimed invention.

It is important to note that each word in the claim is important and should use the inventor's definition noted in the "Definitions" set forth in the V. Summary of the Invention above and, because of their importance, are repeated here.

Definitions:

Some of these terms set forth in the specification and included in the claims have special meanings as follows:

6. Literary work – “At a minimum, a literary work must comprise at least 100 words or more and constitute an original work of authorship.” See page 3, lines 24 and 25.
7. Associated with an advertisement – “Associated with an advertisement (e.g., a corporate name, a product name, a slogan, logo, icon, web site address, sound, description or illustration of product or service, or other promotional device). Some or all of the playing pieces may not include advertisements, but could instead be distributed in conjunction with an advertising campaign. As one example, a competition sponsor may distribute pieces from its stores or by mail with the advertising implicit in the distribution from the sponsor.” See page 4, lines 2 to 8.
8. Playing pieces – “Playing pieces can comprise physical objects (e.g. cards, plastic tablets, and the like) or an intangible object (e.g., a computer-generated display on a web page. Combinations of the two are also possible, such that some playing pieces are distributed in the form of physical objects while other playing pieces are distributed over the Internet (e.g., displayed on the web sites of sponsors.” See page 5, lines 14 to 18.

9. Prize – “A prize such as books, cash, scholarships, computers, trips, awards, recognition, or the like.” See page 6, lines 11 and 12.
10. Distinct parts – “distinct parts, each of which has no readily apparent relation to the other parts.” See page 2, line 17. “Distinct part of the same literary work that contain a number of words, but which cannot be readily correlated with other playing pieces without reading the distinct part of the literary work in each playing piece.” See page 5, lines 1 to 3.

Claim Chart:**Table 1 – Comparison of elements of claim 26 with Hopkins and Pritchard:**

Claim 26	I. <u>Hopkins</u>	II. <u>Pritchard</u>
A. A method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement, comprising:	<p>No. Hopkins disclosure does not relate to promoting literacy and reading. Likewise, it does not show a competition related to a “literary work”.</p> <p>It is to be noted that the literary work must be at least 100 words and constitute an original work of authorship.</p> <p>Instead, Hopkins is a puzzle lottery in which all the puzzles are <u>pictures</u>. There is no method for promoting <u>literacy and reading</u>.</p>	<p>No. Pritchard’s disclosure does not relate to promoting literacy and reading. Likewise, it does not show any competition nor is there any competition related to a “literary work”.</p> <p>It is to be noted the literary work must be at least 100 words and constitute an original work of authorship.</p> <p>Instead, Pritchard is a picture-puzzle with pictures on all the individual stamps and with a few words on some of the stamps. Even when assembled, there is no message shown that is longer than 28 words and this is far short of the definition of literary work used by the applicant.</p>
B. dividing a literary work comprising a correctly ordered sequence of words into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of words in said literary work;	<p>No. There is no teaching of dividing a “literary work”. There is no teaching of a “correctly ordered sequence of words” and no “distinct parts” for determining “the correct sequence of words in said literary work”.</p>	<p>No. There is no teaching of dividing a “literary work”. There is no teaching of “distinct parts” for determining “the correct sequence of words in said literary work”. There is no “literary work”.</p>

Claim 26	III. <u>Hopkins</u>	IV. <u>Pritchard</u>
C. creating a plurality of playing pieces, each of said playing pieces comprising one of said distinct parts;	No. There is no creating playing pieces where the pieces “comprise one of said distinct parts”. As used herein, the definition for said “distinct part” includes a relationship to the literary work. See page 5, lines 1 to 3.	No. There is no creating playing pieces where the pieces “comprise one of said distinct parts”. As used herein, the definition for said “distinct part” includes a relationship to the literary work. See page 5, lines 1 to 3.
D. creating an advertisement;		
E. distributing said plurality of playing pieces comprising one of said distinct parts to members of the public in association with said advertisement;	No. There is no teaching of distributing the playing pieces, which has a “distinct part” as that term is used herein. “Distinct part must include a relationship to the literary work.	No. There is no teaching of distributing the playing pieces, which has a “distinct part” as that term is used herein. “Distinct part must include a relationship to the literary work.
F. collecting said playing pieces comprising one of said distinct parts;	No. There is no teaching of collecting “said playing pieces comprising one of said distinct parts” as that term is used herein.	No. There is no teaching of collecting “said playing pieces comprising one of said distinct parts” as that term is used herein.
G. sequencing said playing pieces into a correctly ordered sequence of words in said literary work;	No. There is no teaching of “sequencing said playing pieces into a correctly ordered sequence of words in said literary work”. There are no words in Hopkins’ puzzle.	No. There is no teaching of “sequencing said playing pieces into a correctly ordered sequence of words in said literary work”. There is no sequencing of words in a literary work.
H. sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work; and	No. There is no teaching of “sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work”. There are no words in Hopkins’ puzzle.	No. There is no teaching of “sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work”. There is no sequencing of words in a literary work.

Claim 26	V. <u>Hopkins</u>	VI. <u>Pritchard</u>
I. winning a prize for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work.	No. There is no teaching of winning a prize “for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work”. There are no words in Hopkins’ puzzle.	No. There is no teaching of winning a prize “for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work”. There is no sequencing of words in a literary work.

Comments as to the Applicable Law:

As can be seen from the above claim chart, most elements of claim 26 are not found in either of the two references so they cannot be combined to show the claimed invention since the combination would still not have most of the elements. The claimed invention is clearly patentable thereover. It is believed the Examiner has used Applicant’s own disclosure as a blueprint to try and mosaic together components from two different references to attempt to show the claimed invention. Even then, most of the steps would be missing from any proposed combination. This is a classic case of hindsight knowledge. If one of ordinary skill in the art had both references prior to Applicant’s invention, they would never have created the claimed invention. This is in effect “using that which the inventor has taught against its teacher”. (W.L. Gore v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983).

The law requires that, in order to prevent the use of hindsight based on the invention to defeat patentability of the invention, there must be shown a motivation to combine the references that create the case of obviousness, in other words, there must be

shown reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). The central question is whether there is a reason to combine the references, a question of fact drawing on the Graham factors.

The factual inquiry whether to combine references must be thorough and searching. *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding”) (quoting *C. R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (“there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant”); *In re Fine*, 5 USPQ2d 1596, 1600

(Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp. 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 f.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”).

The dependent claims 27 and 28 should be allowable for the same reason claim 26 is allowable.

The very essence of Applicant’s invention of a method for promoting literacy and reading is simply not shown by the two references. Each of the references relates primarily to pictures or illustrations and do not relate to promoting literacy and reading.

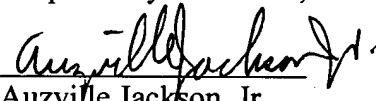
It is believed the three claims are clearly patentable in their present form.

IX. CONCLUSION

The Examiner is incorrect in his analysis of the claims because he ignored the limitations in the preamble and failed to let applicant act as her own lexicographer in defining the words used in the claim. If the preamble and claims are properly read it is clear that applicant has invented and properly claimed an important and much needed invention.

Based on the above, Applicant believes all of the present claims are allowable and that the Examiner's Final Rejection should be reversed.

Respectfully submitted,

 7/30/04
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APPENDIX:

COPY OF CLAIMS:

26. A method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement, comprising:

- dividing a literary work comprising a correctly ordered sequence of words into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of words in said literary work;
- creating a plurality of playing pieces, each of said playing pieces comprising one of said distinct parts;
- creating an advertisement;
- distributing said plurality of playing pieces comprising one of said distinct parts to members of the public in association with said advertisement;
- collecting said playing pieces comprising one of said distinct parts;
- sequencing said playing pieces into a correctly ordered sequence of words in said literary work;
- sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work; and
- winning a prize for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work.

27. The method of claim 26 wherein said advertisement is a corporate name.

28. The method of claim 26 wherein said advertisement is an advertising campaign.